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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,542

09/23/2003

Gregory Piskun

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2121

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7590

02/13/2009

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/668,542	Applicant(s) PISKUN, GREGORY	
	Examiner MATTHEW J. KASZTEJNA	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 20-25, 29, 32, 34, 36 and 41-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 20-25, 29, 32, 34, 36 and 41-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 31, 2008 has been entered.

Notice of Amendment

In response to the amendment filed on December 31, 2008, amended claims 17-18, 20-25, 29 and 41; canceled claims 28 and 33; and new claims 42-51 are acknowledged. The following new grounds of rejection are set forth:

Claim Objections

Claims 17 and 21 are objected to because of the following informalities: Applicant is advised to be consistent with all terminology and limitations throughout all claims. Applicant refers to "an instrument holder assembly", then refers to a "holder assembly". Appropriate correction is required. Claim 17 also has a period ending the sentence in line 18 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17-18, 20-25, 29, 34, 41-43 and 46-48 are rejected under 35

U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,558,371 to Dorn.

In regard to claims 17, Dorn discloses an instrument holder assembly 10 for laparoscopic surgical operations, the holder assembly having an insertion configuration for insertion of the holder assembly through an incision in a patient for at least partial insertion of the holder assembly into a patient cavity, and an in use configuration for use of the instrument holder assembly for access to the patient cavity (see Fig. 1 and Col. 2, Lines 44-49), the holder assembly comprising: a flexible member 24 having a surrounding edge; an at least partially flexible wall 16 surrounding the flexible member, the wall being connected to the flexible member all along the edge (see Fig. 1), the wall having a longitudinal axis, the flexible member extending substantially transversely to the axis, the wall extending away from the flexible member at least in a direction away from a patient (see Col. 5, Lines 43-63), a plurality of cannulas connected to and extending from the flexible member inside of the wall (see Col. 5, Lines 67 - Col. 6, Line 11), the cannulas defining a plurality of separate and mutually spaced apertures for receiving respective elongate laparoscopic surgical members (Dorn clearly discloses multiple channels maybe formed within retainer 24), wherein the flexible member and the flexible walls are *configured* so as to enable the instrument holder assembly, for the

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insertion configuration, to be folded into a compact configuration for the insertion of the holder assembly at least partially through the incision in a patient. It is noted that the words "configured", "to enable" and "to be" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. **In regard to claim 21**, Dorn discloses an instrument holder assembly wherein the wall has two end portions extending as perimetrical flanges to the flexible member, the end portions extending in opposite directions away from the flexible member (See Fig. 6). All other limitations of claim 21 are substantially similar to those of claim 17 and rejected as seen above.

In regard to claim 18, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the flexible member and the wall each have a height dimension extending parallel to the axis, the height dimension of the wall being substantially greater than the height dimension of the flexible member (see Figs. 1 and 6).

In regard to claim 20, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the wall has at least one end portion extending as a flange to the flexible member on the side of the flexible member opposite the patient (see Figs. 1 and 6).

In regard to claims 22-23, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the flexible member is located at one end of the wall (see Fig. 1).

In regard to claim 24, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the flexible member and the wall form a two cup shapes (see Fig. 6).

In regard to claim 25, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the wall has a first inner diameter at the flexible member and second inner diameter at an end opposite the flexible member the second inner diameter being larger then the first inner diameter (see Fig. 6).

In regard to claim 29, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the cannula and instrument holder consists of the flexible member and the wall (see Figs. 1 and 6).

In regard to claim 34, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the wall is at least partially curved in a direction parallel the axis (see Figs. 1 and 6).

In regard to claim 41, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the cannulas 28 all extend in a common direction away from the flexible member so that the cannula are all disposed on only one side of the flexible member (See Figs. 1 and 6 and Col. 5, Line 67).

In regard to claims 42 and 47, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the instrument holder assembly is configured to be inflatable and deflatable (see Col. 6, Lines 17-30).

In regard to claims 43 and 48, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the instrument holder assembly is *configured* to be inflatable when in the insertion configuration to assume the in use configuration. The phrase “configured to be inflatable when in the insertion configuration is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In regard to claim 46, Dorn discloses an instrument holder assembly for laparoscopic surgical operations, wherein the wall extending away from the flexible member at least in a direction away from a patient thereby defines together with the flexible member, in the in use configuration, a cup shape on a side of the flexible member opposite the patient (See Figs. 1 and 6).

Claims 17-18, 20-21, 24-25, 29, 34 and 41-50 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,008,377 to Beane et al.

In regard to claims 17, Beane et al. disclose an instrument holder assembly 10 for laparoscopic surgical operations, the holder assembly having an insertion configuration for insertion of the holder assembly through an incision in a patient for at least partial insertion of the holder assembly into a patient cavity, and an in use

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configuration for use of the instrument holder assembly for access to the patient cavity (see Figs. 2a-e), the holder assembly comprising: a flexible member 230 having a surrounding edge 232; an at least partially flexible wall 66 surrounding the flexible member, the wall being connected to the flexible member all along the edge, the wall having a longitudinal axis, the flexible member extending substantially transversely to the axis, the wall extending away from the flexible member at least in a direction away from a patient (see Fig. 9), a plurality of cannulas 118, 120 connected to and extending from the flexible member inside of the wall (see Col. 10, Lines 57-60), the cannulas defining a plurality of separate and mutually spaced apertures for receiving respective elongate laparoscopic surgical members (see Figs. 8-9 and Col. 10, Lines 21-25), wherein the flexible member and the flexible walls are *configured* so as to enable the instrument holder assembly, for the insertion configuration, to be folded into a compact configuration for the insertion of the holder assembly at least partially through the incision in a patient (see Col. 6, Lines 25-26). Furthermore, it is noted that the words “configured”, “to enable” and “to be” in the claims may be properly interpreted as “capable of,” and “capable of” does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. **In regard to claim 21**, Beane et al. disclose an instrument holder assembly wherein the wall has two end portions extending as

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perimetrical flanges to the flexible member, the end portions extending in opposite directions away from the flexible member (See Fig. 9). All other limitations of claim 21 are substantially similar to those of claim 17 and rejected as seen above.

In regard to claim 18, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the flexible member and the wall each have a height dimension extending parallel to the axis, the height dimension of the wall being substantially greater than the height dimension of the flexible member (see Figs. 1 and 6).

In regard to claim 20, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the wall has at least one end portion extending as a flange to the flexible member on the side of the flexible member opposite the patient (see Fig. 9).

In regard to claim 24, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the flexible member and the wall form a two cup shapes (see Figs. 2e, 9).

In regard to claim 25, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the wall has a first inner diameter at the flexible member and second inner diameter at an end opposite the flexible member the second inner diameter being larger than the first inner diameter (see Figs. 2e and 9).

In regard to claim 29, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the cannula and instrument holder consists of the flexible member and the wall (see Figs. 2a-e and 8-9).

In regard to claim 34, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the wall is at least partially curved in a direction parallel the axis (see Figs. 2a-e and 8-9).

In regard to claim 41, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the cannulas 118, 120, 234 all extend in a common direction away from the flexible member so that the cannula are all disposed on only one side of the flexible member (see Figs. 8-9 and Col. 10, Lines 21-25),

In regard to claims 42 and 47, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the instrument holder assembly is configured to be inflatable and deflatable (see Col. 2, Lines 13-27).

In regard to claims 43 and 48, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the instrument holder assembly is *configured* to be inflatable when in the insertion configuration to assume the in use configuration (see Figs. 2a-e).

In regard to claims 44 and 49, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the at least partially flexible wall is substantially rigid (via ring 210) in a region about the flexible member and flexible at least in a distal region of the wall (via skirt 66) inside the patient cavity that is spaced from the flexible member (See Fig. 9 and Col. 10, Lines 43-60).

In regard to claims 45 and 50, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, configured wherein, when the instrument

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holder assembly is in the in use configuration, the distal region of the wall is enabled to be inside the patient cavity (See Fig. 9 and Col. 10, Lines 43-60).

In regard to claim 46, Beane et al. disclose an instrument holder assembly for laparoscopic surgical operations, wherein the wall extending away from the flexible member at least in a direction away from a patient thereby defines together with the flexible member, in the in use configuration, a cup shape on a side of the flexible member opposite the patient (See Fig. 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,558,371 to Dorn in view of U.S. Patent No. 6,042,573 to Lucey.

In regard to claims 36, Dorn discloses an instrument holder assembly 10 for laparoscopic surgical operations wherein the holder may be secure to the body via an anchoring element (see Col. 4, Lines 37-40) but is silent with respect to a hook and eyelet anchoring element. Lucy teaches of an analogous apparatus which can be secured to a patient using any well known means in the art. The tube 24 has a distal section adapted to be mounted to the patient 12. As shown, the distal section includes a flange 44 that can be mounted directly to the patient using an adhesive, by suturing, or by other appropriate means. **In regard to claim 32**, Lucey discloses a cannula and

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instrument holder assembly for laparoscopic surgical operations, wherein the apertures have a longitudinal dimension extending generally parallel to the axis, at least one of the apertures having a curvilinear or arced shape along the longitudinal dimension of the one of the apertures (see Fig. 7 and Col. 5, Lines 50-57). It would have been obvious to one skilled in the art to secure the holding apparatus of Dorn via a hook and an eyelet to provide an alternate means of securing the holding device as taught by Lucy and is well known in the art.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,540,648 to Yoon in view of U.S. Patent No. 6,238,373 to de la Torre et al.

In regard to claim 51, Yoon discloses an instrument holder assembly comprising: an annular body member 12; and a plurality of port elements 18 connected to the body member and extending in a common direction therefrom (see Fig 1 and Col. 4, Lines 20-25). Yoon is silent with respect to the port elements having a tapered funnel shape. De la Torre et al. teaches of an analogous instrument holder assembly 10 wherein the holder has a tapered funnel shape (See Figs. 5-6, 8-11 and 16-18). It would have been obvious to one skilled in the art at the time the invention were made to construct the port elements of Yoon to be funnel shaped in order to assist a user with the insertion of an instrument therethrough and provide better stabilization of the instrument during use as taught by de la Torre et al.

Response to Arguments

Applicant's arguments with respect to claims 17-18, 20-25, 29, 32, 34, 36 and 41-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./
Examiner, Art Unit 3739

2/11/09